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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,026	06/30/2003	**Alan M. Zamore**	93930-257525	7377

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EXAMINER	
SERGENT, RABON A	
ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/608,026	ZAMORE, ALAN M.	
	Examiner	Art Unit	
	Rabon Sergent	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-22,26-28,32,33,38-40 and 44-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *12-22 and 26-28* is/are allowed.

6)☒ Claim(s) *32,33,38,40,44,46,47 and 49* is/are rejected.

7)☒ Claim(s) *39,45 and 48* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The amendment of November 10, 2008 has been entered. In view of the necessity of rejecting claims 32, 33, 38, 40, 44, 46, 47, and 49 over prior art, the finality of the previous Office action has been withdrawn and prosecution on the merits has been reopened. The delay in application of the prior art against the claims is regretted.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 44 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards et al. ('816).

Patentees disclose the radiation crosslinking of polyamide, wherein a polyamide is blended with an allylic monomer crosslinker, such as triallyl isocyanurate, and subjected to radiation. Richards et al. further disclose that the resulting compositions are useful for the production of such articles as heat-shrinkable tubing. See abstract and columns 3 and 4 within Richards et al. Since patentees disclose that the crosslinked polyamides are useful in the production of heat-recoverable shaped articles, the position is taken that the reference encompasses the heating, expanding, and cooling steps of claim 44, because these steps are central to the production of such articles and such would have been fully appreciated by the skilled artisan at the time of invention.

4. Claims 32, 33, 38, 40, 44, 46, 47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bley et al. ('682) in view of Richards et al. ('816).

Bley et al. disclose the encapsulation of a medical device within a shape-memory (i.e.; heat shrinkable) polymeric sheath, wherein polyamide and nylon are disclosed as being suitable polymers for the sheath. See abstract and column 5, lines 22-52, especially lines 24, 27, 35-37, and 50.

5. While Bley et al. fail to disclose how such shape memory polymers are produced, the position is taken that shape memory polymers that correspond to that of applicant were known at the time of invention. Richards et al. disclose the radiation crosslinking of polyamide, wherein a polyamide is blended with an allylic monomer crosslinker, such as triallyl isocyanurate, and subjected to radiation. Richards et al. further disclose that the resulting compositions are useful for the production of such articles as heat-shrinkable tubing. See abstract and columns 3 and 4 within Richards et al. Accordingly, since Richards et al. disclose a heat shrinkable polyamide

composition and since Bley et al. disclose that such shape memory polymers may be used to encapsulate medical devices, the position is taken that one would have been motivated to use the polymer of Richards in the invention of Bley et al., so as to arrive at the claimed invention. This position is consistent with the holding that is *prima facie* obvious to use a known composition for its known function. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

6. Claims 12-22, 26-28, 32, 33, 38-40, and 44-49 are allowable with respect to the examined species of copoly(ether-ester-amide) polymer; accordingly, claims 39, 45, and 48 are objected to as being dependent on a rejected base claim. Claims 12-22 are allowable with respect to the examined species of nylon (polyamide). The remaining species of the claims remain withdrawn from consideration.

Any inquiry concerning this communication should be directed to Rabon Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
November 20, 2008